



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/658,840	09/08/2000	Loren G. Knutson	068520.0104	3094

7590

02/10/2004

Baker Botts LLP
2001 Ross Avenue
Dallas, TX 75201-2980

EXAMINER

SCHLAIFER, JONATHAN D

ART UNIT

PAPER NUMBER

2178

7

DATE MAILED: 02/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application

09/658,840

Applicant(s)

KNUTSON ET AL.

Examiner

Jonathan D. Schlaifer

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 September 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,4,5,6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to application 09/658,840 filed on 09/08/2000, with prior art filed on 11/13/2000, 6/11/2002, 5/7/2003, and 6/26/2003.
2. Claims 1-20 are pending in the case. Claims 1, 4, 7, and 14 are independent claims.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-3 and 7-13 are rejected under 35 USC § 101 as being directed to non-statutory subject matter. The claims are not directed to statutory subject matter because the claimed subject matter: 1) does not fall within one of the four statutory classes of inventions under § 101; and/or 2) falls within the mere idea or abstract intellectual concept exception to § 101.
4. The claimed invention is so abstract and sweeping as to cover the method if practiced by a human operator assisted only by pencil and paper. The claims 1-3 and 7-13 do not include a particular machine or apparatus, and no machine-implemented steps are recited. Every step is capable of performance by the human mind. A method of this sort, traditionally called a "mental process", is not patentable subject matter. "Phenomena of nature", though just discovered, "*mental processes*", abstract intellectual concepts are not patentable as they are the basic tools of scientific and technological work." (Emphasis added).

Gottschalk v Benson, 175 U.S.P.Q. 673, 675 (U.S.S.C 1972). See also, *In re Prate and Wei* 159 U.S.P.Q. 583 (1968), *rehearing*, 162 U.S.P.Q. 571 (1969).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1-2, 4-5, 7, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Kelly et al. (USPN 5,173,853—filing date 3/14/1991), hereinafter Kelly.**
6. **Regarding independent claim 1**, Kelly discloses a method, comprising the steps of: providing a set of predetermined function definitions which are different (in the Abstract, there are a plurality of document Document Application Profiles which serve as functions for document conversions); and preparing a project definition (the project is a structure converter between ODA and CDA, as revealed in the Abstract), said project definition including: a plurality of function portions which each correspond to one of said function definitions in said set (the Document Application Profiles are the function portions, and are defined with definitions), and which each define at least one input port and at least one output port that are functionally related according to the corresponding function definition (the conversion pairs an input with an output); a further portion which includes a source portion identifying a data source and defining an output port

through which data from the data source can be produced (since it is a file conversion, it inherently involves a data source), and which includes a destination portion identifying a data destination and defining an input port through which data can be supplied to the data destination, and binding information which includes binding portions that each associate a respective said input port with one of said output ports (the file conversion inherently binds the source file with the appropriately linked element), at least one of said binding portions being a conditional binding which is responsive to a specified condition for associating a respective said input port with one of a plurality of different said output ports that form a set (in the Abstract, different types of data are handled by appropriate content handlers).

7. **Regarding dependent claim 2**, data which is inherently available to the output ports in said set is the type of information which is being processed, so binding based on content type as in Kelly would necessarily constitute formulating said condition to be a function of data which is available to said conditional binding.
8. **Regarding independent claim 4**, it is a computer-readable medium with a program that performs the functions of claim 1 and is rejected under similar rationale.
9. **Regarding dependent claim 5**, it is a computer-readable medium with a program that performs the functions of claim 2 and is rejected under similar rationale.
10. **Regarding independent claim 7**, Kelly discloses a method, comprising the steps of: providing a set of predetermined function definitions which are different (in

the Abstract, there are a plurality of document Document Application Profiles which serve as functions for document conversions); and preparing a project definition (the project is a structure converter between ODA and CDA, as revealed in the Abstract), said project definition including: a plurality of function portions which each correspond to one of said function definitions in said set (the Document Application Profiles are the function portions, and are defined with definitions), and which each define at least one input port and at least one output port that are functionally related according to the corresponding function definition (the conversion pairs an input with an output), at least one of said function definitions being operative to automatically convert to a predetermined data type any data which is received at the input port thereof as a data type other than said predetermined data type; (according to the Abstract, all files entering the converter emerge as ODA documents and all subparts of the document are handled by document handlers), a further portion which includes a source portion identifying a data source and defining an output port through which data from the data source can be produced (since it is a file conversion, it inherently involves a data source), and which includes a destination portion identifying a data destination and defining an input port through which data can be supplied to the data destination, and binding information which includes binding portions that each associate a respective said input port with one of said output ports (the file conversion inherently binds the source file with the appropriately linked element), at least one of said binding portions being a conditional binding which is

responsive to a specified condition for associating a respective said input port with one of a plurality of different said output ports that form a set (in the Abstract, different types of data are handled by appropriate content handlers).

11. **Regarding independent claim 14**, it is a computer-readable medium with a program that performs the functions of claim 7 and is rejected under similar rationale.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. **Claims 3, 6, 10-13, 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly, further in view of Microsoft Corporation (“Microsoft Word: User’s Guide”, 1993-1994, Version 6.0, p. 590-591).**

13. **Regarding dependent claim 3**, Kelly fails to disclose a method wherein said step of preparing said project definition includes the step of having a user identify, for each said conditional binding, said input port therefor, said set of output ports, therefor, said specified condition therefor, and a relationship between said specified condition and each said output port in said said. However, Microsoft Word, as portrayed by Microsoft Corporation on page 590, involved these steps when opening a document created in another application, because performing

such a translation required identifying a source, a destination location, and a desired format change to perform, in order to make foreign documents accessible in a word processor. It would have been obvious to one of ordinary skill in the art at the time of the invention to have performed a translation in Microsoft Word in order to make foreign documents accessible in a word processor.

14. **Regarding dependent claim 6**, it is a computer-readable medium with a program that performs the functions of claim 3 and is rejected under similar rationale.
15. **Regarding dependent claim 10**, Kelly fails to disclose the step of selecting a text data type to be said predetermined data type. However, Microsoft Corporation, on page 591, shows translation into text in order to facilitate producing a text version of a complex file. It would have been obvious to one of ordinary skill in the art at the time of the invention to have translated a document into text format in order to facilitate producing a text version of a complex file.
16. **Regarding dependent claim 11**, Kelly states in the Abstract that content handlers accept graphics.
17. **Regarding dependent claim 12**, Kelly fails to disclose the step of selecting a text data type to be said predetermined data type. However, Microsoft Corporation, on page 591, shows importing and exporting graphics in order to facilitate managing graphics for a complex file. It would have been obvious to one of ordinary skill in the art at the time of the invention to have imported and exported graphics in order to facilitate managing graphics for a complex file.

18. **Regarding dependent claim 13**, Kelly states in the Abstract that content handlers accept text.
19. **Regarding dependent claim 17**, it is a computer-readable medium with a program that performs the functions of claim 10 and is rejected under similar rationale.
20. **Regarding dependent claim 18**, it is a computer-readable medium with a program that performs the functions of claim 11 and is rejected under similar rationale.
21. **Regarding dependent claim 19**, it is a computer-readable medium with a program that performs the functions of claim 12 and is rejected under similar rationale.
22. **Regarding dependent claim 20**, it is a computer-readable medium with a program that performs the functions of claim 13 and is rejected under similar rationale.
23. **Claims 8-9 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly**
24. **Regarding depending claim 8**, Kelly fails to disclose a method including the step of selecting a numeric data type to be said predetermined data type.

However, it was notoriously well known in the art at the time of the invention that a hexadecimal representation (which is a numeric data type) is a typical representation for files because it is convenient and related to binary. It would have been obvious to one of ordinary skill in the art at the time of the invention to

have used a hexadecimal representation in Kelly because it was know to be convenient and related to binary.

25. **Regarding dependent claim 9**, Kelly states in the Abstract that content handlers accept text and graphics.

26. **Regarding dependent claim 15**, it is a computer-readable medium with a program that performs the functions of claim 8 and is rejected under similar rationale.

27. **Regarding dependent claim 16**, it is a computer-readable medium with a program that performs the functions of claim 9 and is rejected under similar rationale.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

USPN 6,601,108 B1 (filing date 4/12/1999)—Marmor

USPN 5,911,776 (filing date 12/18/1996)—Guck

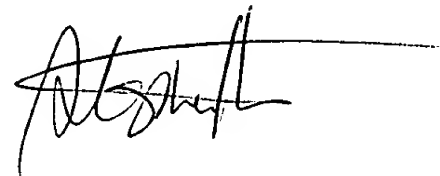
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan D. Schlaifer whose telephone number is 703-305-9777. The examiner can normally be reached on 8:30-5:00; M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 703-308-5186. The fax phone number for the organization where this application or proceeding is assigned is 703-746-7239.

Art Unit: 2178

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

JS

A handwritten signature in black ink, appearing to read 'S. Hong', with a long horizontal line extending to the right.

**STEPHEN S. HONG
PRIMARY EXAMINER**